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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 780,076	02/09/2003	Omar M. Brazza	5040-04203	7773

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EXAMINER	
HECKENBERG JR. DONALD H	
ART UNIT	PAPER NUMBER
1722	11

DATE MAILED: 02/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/780,076

Applicant(s)

BUAZZA ET AL.

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 366-399 and 443-480 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 366-399 and 443-480 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8, 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. Claims 388, 443-449, are objected to because of the following informalities:

The last line of this claim recites that the light source has a peak intensity in the range of "200nm to about 300 run." This is obviously a typographical error and should read "200 nm to about 300 nm." Appropriate correction is required.

Claims 388 and 443-449 begin by reciting "[t]he controller of claim 366..." However, claim 366 defines an apparatus structure, with the controller only being one of the components. The additional limitations in these dependent claims do not further limit the controller. Therefore, these claims should be amended to recite the "The apparatus of claim 366..." as it is the apparatus that is further defined by these claims, similar to the other dependent claims of claim 366.

Claim 449 recites as a new structure that the apparatus comprises a coating unit. However, a coating unit is previously defined in claim 366, from which this claim depends. The disclosure of the instant application provides no support for the apparatus to comprise two coating units. Therefore, it will be assumed that the coating unit defined in this claim is the same coating unit as was defined in claim 366. Appropriate clarification and/or correction is required.

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2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (Cust. & Pat. App. 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (Cust. & Pat. App. 1970); and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (Cust. & Pat. App. 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 366, 383-399, and claim 450 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 293-310

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of copending Application No. 09/780,215 (hereinafter "App. '215") in view of Kachel et al. (US Pat. No. 4,895,102; previously of record).

Claims 366 and 450 of the instant application recite all of the limitations of claim 293 of App. '215. Additionally claim 366 and claim 450 of the instant application recite a coating unit for applying a coating to the eyeglass lens during use. Claims 383-399 of the instant application are identical to claims 294-310 of App. '215.

Kachel teaches a lens forming apparatus in combination with a coating unit which applies abrasion resistant coatings to the formed eyeglass lenses (see col. 8, ln. 38 - col. 10, ln. 34).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus recited in claim 366 and claim 450 of the instant application as such to have added a coating unit because this would have allowed for coatings to be applied to the molded eyeglass lenses and therefore make the lenses more abrasion resistant as suggested by Kachel. Therefore, claim 366 and claim 450 of the instant application are obvious in view of claim 293 of App. '215.

This is a provisional obviousness-type double patenting rejection.

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to

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point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 366-386, 388-399, 446-468, and 470-480 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 318 164 (previously of record; hereinafter "EP '164") in view of Blum (US Pat. No. 4,919,850; previously of record).

EP '164 substantially teaches the apparatus as claimed. As a more specific representation, EP '164 teaches a lens forming apparatus comprising a front mold member (28) having a casting face, a non-casting face, and a front mold identification marking (see p. 4, lns. 35-36), a back mold member (28) having a casting face, a non-casting face and a back mold identification mark (see p. 4, lns. 35-36), the back mold member being spaced apart from the front mold member by a gasket (30) during use, the gasket comprising a gasket identification marking (see p. 4, lns. 35-36), wherein the casting faces of the front mold member and the back mold member and an inner surface of the gasket at least partially define a mold cavity (40) which defines the shape corresponding to an eyeglass prescription, a coating unit

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(20) for applying a coating to the eyeglass lens during use, and a controller comprising an input device for obtaining information from an user, and an output device for transmitting information to the user, wherein the controller is configured to determine the front mold identification marking, the back mold identification marking, and the gasket identification marking in response to the eyeglass prescription being entered through the input device, and wherein the controller is configured to transmit via the output device the front mold identification marking, the back mold identification marking, and gasket identification marking, and wherein the controller is configured to control the operation of the lens curing unit during use (see p. 12, ln. 40 - p. 17, ln. 12).

EP '164 teaches the use of heating ovens to cure the lens molding material (p. 12, lns. 29-35), but fails to teach the lens curing unit to be configured to direct activating light toward the mold members during use in order to cure the lens molding material.

EP '164 also fails to teach the lens curing unit to comprise a first light source and a second light source, wherein the controller is configured to individually control the first and second light sources.

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Blum teaches an apparatus for molding plastic eyeglass lenses which uses ultra-violet light to cure the molding material. Blum notes that UV curing is advantageous to thermal curing because UV curing is much faster (col. 1, lns. 30-55).

Blum further teaches the apparatus to comprise two sets of UV light curing sources (102 and 104) independently controlled by controller in order to tailor the resulting curing to a particular molding material (see col. 6, lns. 37-64).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of EP '164 as such to have used a lens curing unit configured to direct activating ultra-violet light towards the mold members during use because this would speed up the molding process as suggested by Blum.

It also would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of EP '164 as such to have two light sources independently controlled by a controller because this would have allowed the apparatus to be configured to optimally cure particular molding materials as suggested by Blum.

Many of the dependent claims recite features dependent on the specific process that the apparatus is being used in. For example, the range of intensities of activating light as recited

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in claim 458, or the use of multiple light sources and filters as recited in claim 461. It is well settled that the intended use of an apparatus is not germane to the issue of patentability of the apparatus. If the prior art structure is capable of performing the claimed use, then it meets the claim limitation(s). In re Casey, 370 F.2d 576, 580 152 USPQ 235, 238 (Cust. & Pat. App. 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (Cust. & Pat. App. 1963). Further, it is well settled that the optimum values of cause effective variable such is within the skill of one practicing the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (Cust. & Pat. App. 1980); In re Aller, 220 F.2d 454, 105 USPQ 233 (Cust. & Pat. App. 1955). Given the teaching of EP '164 and Blum of the apparatus structure as described, the additional modifications to the operating process of the apparatus would all be within the skill of an ordinary artisan manipulating the apparatus to be optimized to particular processes using the disclosures of EP '164 and Blum and knowledge readily available to one of ordinary skill in the art at the time of the Applicant's invention.

8. Claims 444-445 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP '164 and Blum as applied to claims 366-386,

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388-399, 446-468, and 470-480 above, and further in view of Reiterman (US Pat. No. 3,555,611; previously of record).

EP '164 and Blum teach the apparatus as described above. EP '164 and Blum do not teach the gasket to comprise four discrete projections arranged around on an interior surface of the gasket.

Reiterman teaches an assembly for making plastic lenses comprising a first mold set for forming a lens of a first power, the first mold set comprising a front mold member (11) and a back mold member (12), a gasket (13) for engaging the first mold set, the gasket comprising at least four discrete projections (40) for spacing the front mold member from the back mold member and a fifth projection (31) positioned such that the projection contacts a mold member of the first mold set during use, and wherein the first mold member, the back mold member, and the gasket at least partially define a mold cavity (36) for retaining a lens composition. Reiterman further teaches the at least four discrete projections of the gasket to be evenly spaced at about 90 degree increments (see fig. 1). Reiterman allows for such a configuration in order to allow for operator manipulation of the gasket (column 4, lines 27-39).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the

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apparatus of EP '164 and Blum as such to have used a gasket with projections as taught by Reiterman because this would further allow the apparatus to be manipulated by the operator as necessary.

9. Claims 387 and 469 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP '164 modified by Blum as applied to claims 366-386, 388-399, 446-468, and 470-480 above, and further in view of Buazza et al. (US Pat. No. 6,086,799; previously of record).

EP '164 and Blum teach the apparatus as described above. EP '164 and Blum fail to teach the apparatus to further comprise a light sensor configured to measure the dose of light transmitted to the mold cavity, wherein the light sensor is configured to communicate with the controller, and wherein the controller varies the intensity or duration of light such that a predetermined dose is transmitted to the mold cavity.

Buazza teaches a lens molding apparatus comprising a light sensor configured to measure the dose of light transmitted to the mold cavity and wherein the light sensor is configured to communicate with the controller, and wherein the controller varies the intensity or duration of light such that a

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predetermined dose is transmitted to the mold cavity (col 45, ln. 56 - col. 46, ln. 9).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of EP '164 and Blum as such to have lens molding apparatus further comprise a light sensor working in conjunction with a controller because this would have allowed to the lens to be optimally cured with predetermined doses of light as suggested by Buazza.

10. Applicant's arguments filed December 9, 2002 have been fully considered but they are not persuasive.

With respect to the double-patenting rejection in view of co-pending application 09/780,215, Applicant asserts that the double patenting rejection is incorrect. However, Applicant fails to set forth any reason why the double patenting rejection is incorrect. Applicant therefore has apparently acquiesced to the correctness of the double patenting rejection.

Applicant argues that the combination of a controller configured to determine the mold identification markings and control the lens curing unit operation is not rendered obvious by the combination of EP '164 and Blum. Applicant points out the features of the claimed invention not taught by EP '164, and the

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features of the invention not taught by Blum, and concludes that the combination is therefore not obvious.

One cannot show non-obviousness by attacking references individually where the rejections are based on a combination of references. In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986); In re Keller, 642 F.2d 413, 208 USPQ 871 (Cust. & Pat. App. 1981). The test of obviousness is not express suggestion of the claimed invention in any or all of the references, but rather what the references taken collectively would suggest to those of ordinary skill in the art presumed to be familiar with them. In re Rosselet, 347 F.2d 847, 146 USPQ 183 (Cust. & Pat. App. 1965). In the instant case, the rejection in question was based on the combination of EP '164 and Blum. The combination of the two references teaches all of the features of the claimed invention. The secondary Blum reference further teaches advantageous for the features it is cited to be incorporated into the primary EP '164 reference. Accordingly, there would be proper motivation for one of ordinary skill in the art to combine the references. Thus, as described above, the combination of EP '164 and Blum renders obvious the claimed invention in the instant application.

Applicant further argues that hindsight is used in combining the features of EP '164 and Blum.

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It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (Cust. & Pat. App. 1971). In the instant case, EP '164 and Blum both are teachings that would be familiar to one of ordinary skill in the art of molding plastic eyeglass lenses. As set forth above, there is suggestion within the Blum reference itself for combining its features with the apparatus EP '164 reference. Thus, taking into account only the knowledge within the level of one of ordinary skill in the art at the time of the claimed invention, the combination claimed in instant application would have been obvious.

With respect to claims 368-392, Applicant argues that none of the features in these claims are taught by the prior art.

The features of these claims are taught and/or suggested by the prior art, as set forth in the previous Office Action and repeated above.

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11. Applicant's amendment of new claims necessitated the new grounds of rejection presented in this Office action with respect to the new claims. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

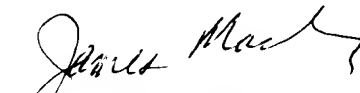
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (703) 308-6371. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at (703) 308-0457. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for responses to non-final action, and 703-872-9311 for responses to final actions. The unofficial fax phone number is (703) 305-3602.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Donald Heckenberg
February 19, 2003


JAMES P. MACKEY
PRIMARY EXAMINER
2/20/03